

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to claim 5 because the recitation of "than" on line 2 thereof should be --that--. Furthermore, the Examiner objects to claim 13 because the Examiner is not clear if the recitation of "f lens" on line 5 thereof is an --f theta lens--. In response, claim 5 has been amended as suggested by the Examiner and claim 13 has been amended to change "f lens" on line 5 thereof to --f theta lens--. Support for the amendment to claim 13 can be found in the specification at page 15, line 9. Thus, no new matter has been entered into the disclosure by way of the amendment to claim 13.

Accordingly, it is respectfully requested that the objection to claims 5 and 13 be withdrawn.

In the Official Action, the Examiner rejects claims 3 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that claim 3 is not clear if the illumination light source is a laser or white light source or both a laser and white light source. In response, claim 3 has been amended to clarify that the illumination light source is one of a laser and white light source. The amendment to claim 3 is fully supported in the original disclosure, particularly in the specification at page 24, lines 20-26. Thus, no new matter has been entered into the disclosure by way of the amendment to claim 3. Accordingly, it is respectfully requested that the rejection of claims 3 and 4 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1-3, 6, 9-16, 21 and 25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,663,560 to MacAulay et al., (hereinafter "MacAulay"). Additionally, the Examiner rejects claims 4, 22 and 23 under

35 U.S.C. § 103(a) as being unpatentable over MacAulay. Furthermore, the Examiner rejects claims 5, 7, 8, 19 and 24 under 35 U.S.C. § 103(a) as being unpatentable over MacAulay in view of U.S. Patent No. 6,128,077 to Jovin et al., (hereinafter "Jovin"). Lastly, the Examiner rejects claims 17, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over MacAulay in view of U.S. Patent No. 6,922,279 to Sun et al., (hereinafter "Sun").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claim 1 has been amended to clarify its distinguishing features.

The MacAulay patent discloses illumination light going through the scanning member, the first light modulation member and then to a sample body. In contrast, the present application discloses the illumination light going through the first light modulation member, the scanning member and then to a sample body. To clarify this distinction, claim 1 has been amended to change the phrase "at least one scanning member for altering the angle of illumination;" to --at least one scanning member for altering the angle of illumination, the at least one scanning member being disposed between the first light modulation member and a sample body--. Claim 1 has also been amended to be consistent with the above change. Specifically, claim 1 has been further amended to change the phrase "an objective lens for projecting the light to which the shading has been imparted to a sample body;" to --an objective lens for projecting the light to which the shading has been imparted to [[a]] the sample body--.

The amendments to claim 1 are fully supported in the original disclosure, including the Figures. Thus, no new matter has been introduced into the disclosure by way of the amendment to claim 1.

With regard to the rejection of claims 1-3, 6, 9-16, 21 and 25 under 35 U.S.C. § 102(b), a scanning optical microscope having the features discussed above and as recited in independent claim 1, is nowhere disclosed in MacAulay. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claim 1 is not anticipated by MacAulay. Accordingly, independent claim 1 patentably distinguishes over MacAuley and is allowable. Claims 2, 3, 6, 9-16, 21 and 25 being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-3, 6, 9-16, 21 and 25 under 35 U.S.C. § 102(b).

With regard to the rejections of claims 4, 5, 7, 8, 17-20 and 22-24 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 4, 5, 7, 8, 17-20 and 22-24 are at least allowable therewith because they depend from an allowable base claim.

In other words, independent claim 1 is not rendered obvious by the cited references because neither the MacAulay patent, the Jovin patent nor the Sun patent, whether taken alone or in combination, teach or suggest a scanning optical microscope having the features discussed above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 4, 5, 7, 8, 17-20 and 22-24, being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 4, 5, 7, 8, 17-20 and 22-24 under 35 U.S.C. § 103(a).

Furthermore with regard to claims 17, 18, and 20, Applicants respectfully submit that the Sun reference does not have an earlier filing date in the United States than the

---

<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

present application. The present application claims the benefit of U.S. Provisional Application Serial No. 60/433,825 filed on December 16, 2002. Thus, the earliest effective U.S. filing date of the present application is December 16, 2002, which antedates the U.S. filing date of the Sun reference (September 20, 2003). Therefore, the Sun reference is not a proper reference to be applied against claims 17, 18 and 20 in the present application. Accordingly, the 35 U.S.C. § 103(a) rejection of claims 17, 18, and 20 citing Sun must be withdrawn.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,  
Thomas Spinelli  
Registration No. 39,533

Scully, Scott, Murphy & Presser  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
516-742-4343

TS:cm/dg